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| 09/602,198 | 06/22/2000 | Theodore G. Habing | 068757.P063C | 8408 |
| 26389 | 7590 | 06/04/2004 | EXAMINER | |
| CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC 1420 FIFTH AVENUE SUITE 2800 SEATTLE, WA 98101-2347 | | | HWANG, VICTOR KENNY | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3764 | 22 |

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Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. 09/602,198 | Applicant(s) HABING ET AL. |
|------------------------------|-------------------------------|-------------------------------|
| | Examiner Victor K. Hwang | Art Unit 3764 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 26 February 2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 32-36,40,42,43,45-47,49-57,59,60 and 65-67 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 32-36,40,42,43,45-47,49-57,59,60 and 65-67 is/are rejected.

7) Claim(s) 52,57 and 67 is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____.

DETAILED ACTION***Claim Objections***

1. Claims 52, 57 and 67 are objected to because of the following informalities:

in claims 52 and 57, line 2 of each claim, the recitation "the upper portion" presumably should be replaced with --the upright portion-- to correct a lack of antecedent basis for "the upper portion"; and

in claim 67, line 2, the recitation "the transverse cross member" lacks antecedent basis and presumably the main arm member further comprises a transverse cross member.

Appropriate correction is required.

Claim Rejections - 35 USC § 102 and 103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 32-36, 40, 42, 46, 47, 49-55, 57, 60, 65 and 67 are rejected under 35 U.S.C. 102(b) as being anticipated by *Deola* (US Pat. 4,949,951). *Deola*'951 discloses an exercise apparatus comprising a frame 12 with an upper region and a main pivot axis 28 located in the upper region and being transverse to fore and aft directions. A press arm 14 has a main arm member 14 and a pair of secondary arms 16. The main arm member includes an upright portion 26 located in a vertical plane and having an upper end and a lower end below the upper end, the upper end being pivotally coupled to the main pivot axis, and a transverse cross member 24 having a middle region 24 nonrotatably connected to the lower end of the upright portion and first and second ends 20,22 located laterally outward of either side of the middle region.

The secondary arms extend downwardly below horizontal when at rest and are pivotally connected to the opposite ends of the transverse cross member to pivot about secondary axes. The secondary axes are laterally spaced apart, inclined from vertical in the forward direction when at rest, located below the main pivot axis at all times, located aft of the main pivot axis in at least one starting position, are substantially parallel to each other, and are orthogonal to the main pivot axis. During use, the secondary arms are capable of pivoting inward and outward about their respective secondary axes while the combination is simultaneously pivoting about the main pivot axis, thus allowing the user to perform either a straight chest press exercise motion or one incorporating a butterfly motion therewith.

A source of resistance 18 is coupled to the press arm and comprises a weight 128 coupled to the press arm via one or more cables 36,38.

5. Claims 32-36, 45-47, 49-51, 54, 59 and 60 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over *Deola* (US Pat. D359,326). *Deola* '326 has been previously discussed in the Office Action of Paper No. 18, and such discussion is incorporated herein. The design features of *Deola* '326 show structure having clear inherent functionality. For example, it is not necessary for there to be a description describing the weight stack as being a source of resistance for exercise. The drawings show structure for which the function is clear to those having ordinary skill in the exercise art.

6. Claims 32-34, 40, 42, 43, 46, 53-56, 60 and 65-67 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over *Simonson* (US Pat. 5,643,152). *Simonson* discloses an exercise apparatus comprising a frame 10 with an upper region and a main pivot axis 46 located in the upper region generally transverse to fore and aft directions. A press arm has a main arm member 31 and a pair of secondary arms 60, the main arm member pivotally connecting to the frame about the main pivot axis, the secondary arms extending downwardly below the horizontal when at rest and pivotally connecting to the main arm member about secondary axes 48,49, the secondary axes being laterally spaced apart and inclined from the vertical in a forward direction. A source of resistance 70 is coupled to the press arm wherein the source of resistance comprises a weight 23 coupled to the press arm via one or more cables 40.

During use, the secondary axes are at all times located below the main pivot axis. During use, the secondary arms are capable of pivoting inward and outward about their

respective secondary axes while the combination is simultaneously pivoting about the main pivot axis, thus allowing the user to perform either a straight chest press exercise motion or one incorporating a butterfly motion therewith. The secondary arms may rotate about axes that are substantially parallel to each other, wherein the secondary axes are orthogonal to the main pivot axis (Fig. 1B, 8-12, 14-16, 18-20). The secondary arms extend at an oblique angle relative to their respective pivot axes.

Response to Arguments

7. Applicant's arguments filed January 23, 2004 have been fully considered but they are not persuasive. Applicant argues that *Deola* '326 as a design patent is to be construed narrowly to what is actually pictured in the design patent. What is pictured is an exercise apparatus comprising certain visible structural elements. It can be clearly seen that there is a weight stack connected by a cable and pulleys to a press arm. The press arm has pivots and secondary arms attached by a universal-type joint. One having ordinary skill in the exercise art would recognize that the secondary arms are shown in a during use position, and that the secondary arms would extend downwardly in an at rest position with the secondary pivot axes inclined from vertical in a forward direction. It is proper to take into consideration not only the teachings of the prior art, but also the level of ordinary skill in the art. *In re Luck*, 476 F.2d 650, 177 USPQ 523 (CCPA 1973). Specifically, those of ordinary skill in the art are presumed to have some knowledge of the art apart from what is expressly disclosed in the references. *In re Jacoby*, 309 F.2d 241, 162 USPQ 224 (CCPA 1969).

In response to Applicant's arguments that *Hecox* does not disclose that the pivot arm and arm levers move simultaneously to allow the user to perform either a straight chest press exercise motion or one incorporating a butterfly motion, the claims as amended require that such motion be during use and that the structure merely be capable of such motion. The law of anticipation requires that a distinction be made between the invention described or taught and the invention claimed. It does not require that the reference "teach" what the subject patent teaches. Assuming that a reference is properly "prior art," it is only necessary that the claims under consideration "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or "fully met" by it. The structure of *Hecox* is capable of the movement claimed. *Hecox* does not disclose the use of weight resistance.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cheng (US Pat. 5,653,669), *Hsieh* (US Pat. 5,665,036), *Chu* (US Pat. 6,234,941 B1), *Webber et al.* (US Pat. 6,579,213 B1), *Webber et al.* (US Pub. No. 2003/0195091 A1), *Baumler* (US Pat. 6,689,023 B2), *Webber et al.* (US Pub. No. 2004/0029688 A1) and *Chen* (Taiwan Pat. Pub. No. 331154) disclose exercise apparatus comprising press arms similar to Applicant's claimed press arm.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor K. Hwang whose telephone number is (703) 308-2865. The examiner can normally be reached Monday through Friday from 7:30 AM to 4:00 PM Eastern time. The facsimile number for submitting papers directly to the examiner for informal correspondence is (703) 746-4891. The facsimile number for submitting all formal correspondence is (703) 872-9306.

Any Inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 3700 receptionist at (703) 308-0858.



NICHOLAS D. LUCCHESI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700



Victor K. Hwang
May 21, 2004